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| Siemens Corporation Intellectual Property Department 170 Wood Avenue South Iselin, NJ 08830 | | | EXAMINER PHUNG, LUAT | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/529,720

Applicant(s)

BOZIONET ET AL.

Examiner

LUAT PHUNG

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20, 21, 23-27, 29-36 and 39-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 20, 21, 23-27, 29-36, 39, 40, 42 and 43 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's arguments have been fully considered but they are either not deemed to be persuasive or are moot in view of the new ground(s) of rejection.

2. On page 10, applicants argue that:

Examiner did not identify a specific element in Potter corresponding to Applicant's claimed "data processing device". Instead, Examiner on page 5 of the office action listed several different types of elements in Potter, including clients 44, 46, 48, 50; a gateway 36; a gatekeeper 40; communications lines 14, 15; and a LAN node 38. In order to clarify Applicants' element in the amended claims, it is renamed "interface" (24), as described in par. 59, lines 7-17; par. 62 lines 8-13; and FIG 2.

Examiner respectfully disagrees because:

The arguments are moot in view of the amended claim—"data processing device" in the original claim has been replaced.

3. On page 10, applicants argue that:

The interface 24 in the gatekeeper module 21 handles multiple transmission protocols and converts between them as described and claimed. Potter shows and describes a distributed communications system. FIG 2 shows a switch 42, a gateway 36, a gatekeeper 40, and a computer 54, all separately connected to a LAN or WAN 22. Potter emphasizes a distributed topology in paragraph 10, stating benefits that teach away from the integrated aspect of the present invention as claimed. In contrast, Applicants invention eliminates the need for separate protocol conversion computers

(Applicants FIG 1, dashed elements 8, 18a, 18b) by providing a protocol conversion interface 24 in a gatekeeper module 21 in a computer or PBX 15a that also includes a gatekeeper 21, multiple gateways 20a, 20b, an alternate resource selector 27, protocol conversion, and at least in the case of a PBX, a switch. This is a purpose of the present invention (page 12, lines 5-12).

Examiner respectfully disagrees because:

If Applicants argue "integrated aspect" of the invention, Examiner does not see such a limitation in the claims. In response to applicants' argument that the references fail to show certain features of applicants' invention, it is noted that the features upon which applicant relies (i.e., "integrated aspect") are not recited in the rejected claim. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The arguments are further moot in view of the new grounds of rejection. It is noted that new claim 41 is based on original claim 19, and the amended claim now includes new limitation "a computer", *inter alia*, which replaces "a data communications system" in the original claim.

4. On pages 10-11, applicants argue that:

Srinivasan shows and describes a communications system with distributed backup servers (FIGs 1-3, elements 120a-d, and par 32, lines 5-15). Examiner apparently holds these servers to correlate with Applicants' internal gateway modules 20a, 20b. If so, the topology and function of Srinivasan's servers teach away from

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integration thereof in a PBX or computer as claimed. Backup servers should be remote from each other, so that a local network or ISP failure does not eliminate all or multiple servers. Srinivasan's servers are redundant, meaning in this case that they all receive the same client requests, and concurrently process the same client requests redundantly (par. 11 and 34). This is a duplication of both hardware and processing for the purpose of fault-tolerant redundancy. It does not correlate with any claimed feature of Applicants. Neither Applicants nor Potter mention "fault" or "malfunction" or "failure" or "backup" or "redundancy", so the function and system of Srinivasan is largely unrelated to Potter and to Applicant's invention.

In any case, Srinivasan's backup servers would not be operable as alternate gateways in Applicants' system based on load, because they all have the same duplicated traffic load (par. 34). Thus, they all must handle the load of all of the client requests concurrently. If a network is interrupted such that the master server loses communication with backup servers, they elect a new master, resulting in conflicting masters (par. 15). Again, this is unrelated to Potter and to Applicants' invention.

Examiner respectfully disagrees because:

The arguments are moot in view of the new grounds of rejection. It is noted that new claim 41 is based on original claim 19, and the amended claim now includes new limitation "due to data traffic loading thereof", inter alia.

5. On page 11, applicants argue that:

As Examiner noted, Potter does not disclose a resource control device. Neither Potter nor Srinivasan mention "load", which is the basis for Applicants' alternate resource selection as claimed.

Examiner respectfully disagrees because:

If Applicants argue that "load" is the basis for Applicants' alternate resource selection, Examiner does not see such a limitation in the original claims. In response to applicants' argument that the references fail to show certain features of applicants' invention, it is noted that the features upon which applicant relies (i.e., "load") are not recited in the rejected claim. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The arguments are moot in view of the new grounds of rejection. It is noted that new claim 41 is based on original claim 19, and the amended claim now includes new limitation "due to data traffic loading thereof", inter alia.

6. On page 11, applicants argue that:

It is unclear how Srinivasan could be combined with Potter. In part, this is because Examiner's proposed correspondence with Applicants' "data processing device" in Potter is unclear, as noted in the first paragraph above. Examiner's response to the amendments herein may clarify this proposed combination. However, it is clear for the reasons above that no combination of Srinivasan and Potter would produce in Applicant's invention as claimed.

Examiner respectfully disagrees because:

The arguments are moot in view of the new grounds of rejection.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 20, 21, 23-27, 29-36, 39, 40, 42 and 43, drawn to a data communications system, and corresponding method, for executing a teleconference among clients supporting different protocols, classified in class 370, subclass 261 (Technique for setting up a conference call).
 - II. Claim 41, drawn to a computer comprising of conference devices, an interface supporting conversion between two protocols, and a resource control device, due to data traffic loading, causing another device to take over a request for a teleconference, classified in class 718, subclass 105 (Load balancing).
7. The inventions are independent or distinct, each from the other because:
- Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination II has separate utility such as load balancing by causing another device to take over a request for a teleconference. See MPEP § 806.05(d).

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the

allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

8. The inventions are distinct, each from the other because of the following reasons:

Newly submitted claims 39, 40, 42 and 43 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Independent claims 39 and 42 directed to a system and method for executing a teleconference among clients supporting different protocols. The new dependent claims 40 and 43, and existing dependent claims 20, 21, 23-27 and 29-36 belong to the group I. Group II comprises new claim 41, which replaced original claim 19 and directed to a computer supporting load balancing by causing another device to take over a request for a teleconference. The original dependent claims 20, 21, 23-27 and 29-36 have been examined as shown in the previous office action.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 20, 21, 23-27, 29-36, 39, 40, 42 and 43 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

9. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected invention.**

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election

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shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. Claim 41 is rejected under U.S.C. 103(a) as being unpatentable over Potter, et al (US Pub. 2001/0043608) in view of Detampel, et al. (US Pub. 2001/0002927), and further in view of Pinard, et al (US 6,819,665).

Regarding claim 41, Potter discloses a computer system comprising:

a plurality of telephone and/or video conference data processing devices supporting a first data transmission protocol; (multimedia terminals handling voice, data, telephony services per Fig. 2, elements 44, 46, 48, 50 and para. 8, 26, 34, 35; also business application placing and receiving calls using CSTA protocol per Fig. 2, element 52 and para. 34)

an interface in a gatekeeper module (Fig. 2, element 40) supporting both the first, and also a second data transmission protocol, the gatekeeper module converting received data from the second to the first data transmission protocol (gatekeeper carrying out translation between CTSA and H.232 per para. 34) and forwarding converted data to one of the telephone and/or video conference data processing devices (multimedia terminals receiving calls, capable of dealing with two or more calls of different types--voice, video, data--per para. 8, 26, 34, 35), wherein clients using the first data transmission protocol and clients using the second data transmission protocol can simultaneously use said one of the telephone and/or video conference data processing devices. (calls of different types--voice, ISDN, H.323 and so on--from external network can communicate with terminals which uses CSTA per para. 2, 25, 26, 34, 35)

Potter does not explicitly disclose a resource control device which in cases in which a request cannot be processed by said one of the telephone and/or video conference data processing devices due to data traffic loading thereof, causes another of the telephone and/or video conference data processing devices to take over the request. Detampel from the same or similar fields of endeavor discloses determining if sufficient ports are available (Fig. 5, element 503) and accordingly selecting a conference bridge considering load control and routing cost and using criteria including availability, load control, least-cost routing and component failure, for example, selecting one with the most available conferencing ports (para. 5, 57). Thus it would have been obvious to the person of ordinary skill in the art at the time of the invention to combine

Potter's multimedia call center with conference selection of Detampel by implementing the conference bridges and selecting one for teleconference based on load and resource availability. The motivation for doing so would have been to provide flexibility and cost saving (para. 5).

The combination of Potter and Detampel does not explicitly disclose the computer comprising the devices, the interface in a gatekeeper module and the resource control device. However Potter discloses a computer system comprising all of these components (multimedia call center per Fig. 2 and para. 24). Additionally Pinard from the same or similar fields of endeavor discloses implementing H.323 standard, including the H.323 gatekeeper, in a PBX with full functionality in a networked environment (col. 2, lines 10-18). Thus it would have been obvious to the person of ordinary skill in the art at the time of the invention to combine the multimedia system of Potter and Detampel with the network PBX of Pinard by integrating the components into a computer. The motivation for doing so would have been to incorporate an emerging standard for multi-media communication to voice communications traditionally implemented in a PBX (col. 1, lines 12-50).

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form 892).

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. Examiner's Note: Examiner has cited particular paragraphs, columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner. In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and, also to verify and ascertain the metes and bounds of the Claimed invention.

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17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luat Phung whose telephone number is 571-270-3126. The examiner can normally be reached on M-Th 7:30 AM - 5:00 PM, F 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu can be reached on 571-272-3155. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/L. P./

Examiner, Art Unit 2616

/Huy D. Vu/

Supervisory Patent Examiner, Art Unit 2616